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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/648,071 | 08/25/2000 | David Yinkai Chao | | 6895 |
| 45599 | 7590 | 11/04/2005 | | |
| GREENBERG TRAURIG LLP MET LIFE BUILDING 200 PARK AVENUE; 14TH FLOOR NEW YORK, NY 10166 | | | EXAMINER | |
| | | | DANG, HUNG XUAN | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2873 | |

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/648,071 | CHAO, DAVID YINKAI | |
| | Examiner | Art Unit | |
| | Hung X. Dang | 2873 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 18 August 2005 .

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 31-40 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 31-40 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____ .

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) Interview Summary (PTO-413) Paper No(s) _____ .

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____ .

1. The RCE filed on 8/18/05 has been entered.

Claims Rejection Under 35 USC - 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 31-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chao** (5,737,054) in view of **Chao** (5,568,207).

Chao '054 disclose that a primary frame (10) including a first bridge (13), the first bridge (13) including a first magnetic (14), an auxiliary lens frame (20) having a second bridge (21) having an arm (22) extended rearward toward the primary frame (10) and extend over the first bridge (13), the arm including a rear end having a flange (24) extended downward for engaging with the first bridge and for securing the auxiliary frame to the primary frame, the flange (24) including a second magnet for engaging with the first magnet (14) and for securing the auxiliary frame to the primary frame. (See figures 1, 2 and 4 and the related disclosure)

Chao '054 does not disclose that two side of the auxiliary frame each having an extension extended rearward toward the primary frame and extended over one of the

studs, the extensions each including a rear end having a first flange extended downward. Chao also does not disclose that

Chao '207, however, discloses that two side of the auxiliary frame (20) each having an extension (21) extended rearward toward the primary frame (10) and extended over one of the studs (11), the extensions (21) each including a rear end having a first flange (22) extended downward (please see figure 15).

Because Chao '054 and Chao '207 are both from the same field of endeavor, the purpose of preventing the auxiliary spectacle frame from moving downward relative to the primary frame as disclosed by Chao '207 would have been recognized as an art pertinent art of Chao '054.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the auxiliary lenses for eyeglasses, such as the one disclosed by Chao '054, with two side of the auxiliary frame each having an extension extended rearward toward the primary frame and extended over one of the studs, the extensions each including a rear end having a first flange extended downward, such as disclosed by Chao '207 for the purpose of preventing the auxiliary spectacle frame from moving downward relative to the primary frame.

Both **Chao** (5,737,054) and **Chao** (5,568,207) fail to disclose each magnetic material of the primary frame engages, in a plane substantially parallel to a plane of a lens of the primary frame, with the corresponding magnetic materials of the auxiliary frame such that the auxiliary frame is secured to and supported by the primary frame.

The limitation each magnetic material of the primary frame engages, in a plane substantially parallel to a plane of a lens of the primary frame, with the corresponding magnetic materials of the auxiliary frame such that the auxiliary frame is secured to and supported by the primary frame, this connecting configuration is considered by the examiner to be an obvious matter of design choice, being just one of many similar ways to connect the auxiliary frame to the primary frame. Applicant has not disclosed that the particular magnetic engagement configuration recited by claims 31 and 36 solves any stated problem or is for any particular purpose that is not equally solved by the magnetic engagement configurations of both **Chao** (5,737,054) and **Chao** (5,568,207) and it appears that the invention would perform equally well with other magnetic engagement configurations, such as those disclosed in these references.

Claims Rejection Under 35 USC - 103

3. Claims 31-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chao** (5,568,207) in view of **Chao** (5,737,054).

Chao '207 discloses auxiliary lenses for eyeglasses which comprising a primary lens frame (10), an auxiliary lens frame (20). The auxiliary lens frame (20) having two magnetic members (22) secure to the arms (21) thereof for engaging with the magnetic members (14) of the primary lens frame (10) for securing the auxiliary lens frame (20) to the primary lens frame (10). **Chao** '207 does not disclose that the bridge of the auxiliary lens frame having an arm extended over the bridge of the primary lens frame for securing the auxiliary lens frame to the primary lens frame.

Chao '054 disclose that the auxiliary lens frame having a middle bridge portion having a projection for engaging over the middle bridge portion of the primary lens frame and having a magnetic connector member for engaging with the connector member of the primary lens frame.

Because Chao '207 and Chao '054 are both from the same field of endeavor, the purpose of providing auxiliary lens frame which may be easily engaged on the primary lens frame as disclosed by Chao '054 would have been recognized as an art pertinent art of Chao '207.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the auxiliary lenses for eyeglasses, such as the one disclosed by Chao '207, with auxiliary lens frame having a middle bridge portion having a projection for engaging over the middle bridge portion of the primary lens frame and having a magnetic connector member for engaging with the connector member of the primary lens frame, such as disclosed by Chao '054 for the purpose of providing auxiliary lens frame which may be easily engaged on the primary lens frame.

Both **Chao** (5,737,054) and **Chao** (5,568,207) fail to disclose each magnetic material of the primary frame engages, in a plane substantially parallel to a plane of a lens of the primary frame, with the corresponding magnetic materials of the auxiliary frame such that the auxiliary frame is secured to and supported by the primary frame.

The limitation each magnetic material of the primary frame engages, in a plane substantially parallel to a plane of a lens of the primary frame, with the corresponding magnetic materials of the auxiliary frame such that the auxiliary frame is secured to and

supported by the primary frame, this connecting configuration is considered by the examiner to be an obvious matter of design choice, being just one of many similar ways to connect the auxiliary frame to the primary frame. Applicant has not disclosed that the particular magnetic engagement configuration recited by claims 31 and 36 solves any stated problem or is for any particular purpose that is not equally solved by the magnetic engagement configurations of both **Chao** (5,737,054) and **Chao** (5,568,207) and it appears that the invention would perform equally well with other magnetic engagement configurations, such as those disclosed in these references.

Claims Rejection, Obviousness Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 31-40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,109,747. Although the conflicting claims are not identical, they are not patentably distinct from each other because claimed invention in claims 31-40 of this application is substantially the same as that in claims of the U.S. Patent No. 6,109,747. All the limitations in claims 31-40 of this application is included in the U.S. Patent No. 6,109,747 and have the same purpose of attaching the auxiliary frame to the primary frame using the magnetic attraction. Thus, the scope of the invention in claims 31-40 of this application is substantially identical to that of claims in the U.S. Patent No. 6,109,747. It appears that these changes produce no functional differences and therefore would have been obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response To Applicant's Argument

6. Applicant's arguments filed 8/18/05 have been fully considered but they are not persuasive.

Applicant argued in the remark that both Chao do not disclose “each magnetic material of the primary frame engages, in a plane substantially parallel to a plane of a lens of the primary frame, with the corresponding magnetic materials of the auxiliary frame such that the auxiliary frame is secured to and supported by the primary frame.”

This argument is not persuasive because:

Both **Chao** (5,737,054) and **Chao** (5,568,207) fail to disclose each magnetic material of the primary frame engages, in a plane substantially parallel to a plane of a lens of the primary frame, with the corresponding magnetic materials of the auxiliary frame such that the auxiliary frame is secured to and supported by the primary frame.

The limitation each magnetic material of the primary frame engages, in a plane substantially parallel to a plane of a lens of the primary frame, with the corresponding magnetic materials of the auxiliary frame such that the auxiliary frame is secured to and supported by the primary frame, this connecting configuration is considered by the examiner to be an obvious matter of design choice, being just one of many similar ways to connect the auxiliary frame to the primary frame. Applicant has not disclosed that the particular magnetic engagement configuration recited by claims 31 and 36 solves any stated problem or is for any particular purpose that is not equally solved by the magnetic engagement configurations of both **Chao** (5,737,054) and **Chao** (5,568,207) and it appears that the invention would perform equally well with other magnetic engagement configurations, such as those disclosed in these references.

Therefore the claimed invention does not distinguish over the Chao references.

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Applicant does not response to the rejection of claims 31-40 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,109,747.

7. Any inquiry concerning this communication should be directed to Examiner Dang at telephone number 571-272-2326.

10/05



HUNG DANG

PRIMARY EXAMINER

TECHNICAL CENTER 2800